

No new matter has been added to the Application by way of any of the amendments to the claims, specification or abstract. While not necessarily in agreement with the rejections made by the Examiner, Applicants have amended the claims to expedite review and allowance. Applicants reserve the right to prosecute the cancelled claim matter in later applications.

Objections to the Disclosure

The Examiner objected to the disclosure on the basis of informalities stating: "reference has been repeatedly made to physiologically active compounds using only code names and/or acronyms in the disclosure at pp. 33 and 41 (e.g. "NECA," "R-PIA," "CPX," "CGS21680," "HENECA," "YT-186," "WRC04070," and "ZM241385"). Applicant is respectfully requested to supply complete chemical structural identification for each of the code-defined chemical substances referred to parenthetically herein as amendments to the disclosure or as a Figure including appropriate Brief Description addition to the disclosure."

Applicants have provided the requested chemical structure identification in the form of a Table. This table has been added as Table 8 on page 43 starting at line 13. A clean copy of page 43 including Table 8 is attached.

Abstract

The Examiner stated that no Abstract was provided by the Applicants. Applicants have provided an abstract, as requested by the Examiner. The abstract, which is numbered page 52, is attached.

Double Patenting over Claims 1-13 of U.S. Patent No. 6,403,567

The Examiner rejected claims 1-12 and 19-26 under the judicially created Doctrine of Double Patenting over Claims 1-13 of U.S. Patent No. 6,403,567. Applicants point out, however, that there was no claim 26 pending prior to this response.

Applicants believe that the Examiner's double patenting rejection of claims 1-12 and 19-25 has been overcome by filing a Terminal Disclaimer contemporaneously with the filing of this Reply.

Rejection of Claim 25 under 35 USC § 101

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Claim 25 was rejected "because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e. results in a claim which is not a proper process claim under 35 USC § 101". The Examiner specifically referred to the use of term "useful" in line 1 of claim 25.

Applicants, while not necessarily agreeing with the Examiner, have amended the claim to remove the word "useful."

No new matter has been added by the amendment to the claim.

Rejection of Claims 1-25 under 35 USC § 112, First Paragraph

Claim 1-25 were rejected under 35 USC § 112, First Paragraph as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner has specifically pointed to claim 1 and claim 19.

While not necessarily in agreement with the rejections made by the Examiner, Applicants have amended claims 1, 2, 3, 4, 5, 6, 7, 19, 20, 23, and 25 to expedite review and allowance, while reserving the right to prosecute the cancelled subject matter in later applications.

No new matter has been added by any of the amendments to the claims.

With the enclosed amendments, Applicants believe that the 35 U.S.C. §112, first paragraph, rejection has been overcome and respectfully ask the Examiner to reconsider the rejection.

Rejection of Claims 18 and 19 under 35 USC § 112, Fourth Paragraph

The Examiner rejected claims 18 and 19 under 35 USC § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Claim 19 was rejected because it "makes improper reference to the subject matter of claim 1 as a "compound of matter of claim 1." The Examiner requested that the Applicants amend the noted term to read "compound of claim 1." Applicants have amended claim 19 to eliminate the words "of matter" thereby obviating the rejection of claim 19 under 35 USC § 112, fourth paragraph.

Applicants have cancelled claim 18 and thus the rejection of this claim is moot.

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No new matter has been added in the above amendment to claim 19.

With these amendments, Applicants believe that the 35 U.S.C. §112, fourth paragraph rejection has been overcome.

Rejection of Claims 1-25 under 35 USC § 112, Second Paragraph

Claims 1-25 were rejected under 35 USC § 112, Second Paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner specifically mentions claims 1, 2, 3, 4, 5, 6, 8, 13, 14, 15, 16, 19, 20, and 23 - 25. Applicants respectfully draw the Examiner's attention to the fact that claims 8-18 have been cancelled in this response.

Applicants have amended claims 1, 2, 3, 4, 5, 6, 7, 19, 20, 23 and 25. Applicants believe that the enclosed amended claims address all the comments made by the Examiner.

Applicants have amended the Markush group wording as requested by the Examiner in claims 1, 2, 3, 4, 5, and 6.

The Examiner requested that the chemical names in claim 19 be separated with a semi-colon. Applicants have complied with this request and, in addition, have started each compound name on a separate line.

The Examiner rejected claim 20 for use of the term dilatation, which he asserts was technically incorrect. However, dilatation is defined as "the condition, as of an orifice or tubular structure, of being dilated or stretched beyond the normal dimensions" in the 26th edition of Dorland's Illustrated Medical Dictionary (W.B Saunders Company). Therefore, the use of the word "dilatation" was correct. However, while not necessarily agreeing with the Examiner, Applicants have amended claim 20 to recite the term "dilation" in accordance with the suggestion made by the Examiner.

Claims 23-25 were rejected because Applicants used the word "the" rather than "a" in claim 23. Applicants are grateful for the Examiner's suggestion. Claim 23 has been amended so that it now recites "a compound of claim 1."

With the enclosed amendments, Applicants believe that the 35 U.S.C. §112, first paragraph rejections have been overcome.

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INVENTORSHIP

The Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made. Applicants confirm the Examiner's presumption that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made.

GENERAL COMMENTS

Claim 1 was amended to break the term "alkyl" into straight or branched C₁₋₁₅ alkyl and C₃₋₈ cycloalkyl in order to clarify the definition of R⁷. Support for the amendment is found in the specification at p.8 lines 9-12. Claim 1 was also clarified by changing the symbol "H" to the word hydrogen in the definition of R.²⁰

Claim 2 was amended in order to change the symbol H to the word hydrogen to clarify the definition of R²⁰.

Claim 3 was amended to make it consistent with claim1 in order to clarify the definition of R⁷. The definition of R⁷ as including hydrogen can be found at p. 5 at line 7. Claim 3 was also amended to include straight or branched C₁₋₁₅ alkyl and C₃₋₈ cycloalkyl in the definition of R⁷. These amendments have a basis in the specification at p.8 lines 9-17.

Claims 5, 6 and 7 were amended for clarification of the invention in view of the amendments to claims 1 through 4.

Claim 20 has been amended to recite that administration is by "intravenous bolus injection". Support for this phrase can be found, for example, on page 32, line 24 and on page 39, lines 30-31. Claim 20 has also been amended to clarify that administration is for the purposes of aiding in imaging the heart.

Claims 26, 27, 28 and 29 were added in order to more fully describe the invention.

In amending claim 19 as the Examiner suggested, Applicants noted a typographical error to one of the compound names. Applicants have requested an amendment to the name for compound 21 that appears on page 25 of the specification. The structure and mass spectral data match. Apparently in typing the name, an extra "methyl" was inadvertently added. Applicants ask that the corrected name be entered, and have supplied a clean page 25 with this response.

No new matter has been added by any of these amendments.

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The Allowability of all Pending Application Claims

Claims 1 through 7, 19, 20, and 22 through 29 are pending as a result of this Reply. Applicants believe that all of pending claims 1 through 7, 19, 20, and 22 through 29 are allowable and that all rejections and objections have been overcome.

Applicants request the Examiner to reconsider his rejections in view of the above arguments and specification, abstract and claim amendments.

Favorable reconsideration on and allowance of the pending application claims is therefore respectfully solicited.

Respectfully submitted,

**McDonnell Boehnen
Hulbert & Berghoff**

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By:


A. Blair Hughes
Reg. No. 32,901
312-913-2123

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